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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,187	03/10/2004	Norbert Rick	MERCK-2862	2740
23599	7590	04/06/2005	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.			MANLOVE, SHALIE A	
2200 CLARENDON BLVD.			ART UNIT	
SUITE 1400			PAPER NUMBER	
ARLINGTON, VA 22201			1755	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,187

Applicant(s)

RICK ET AL.

Examiner

Shalie A. Manlove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoen et al US 2002/0192448.

With regards to claim 1, Schoen teaches an interference pigment comprising:

- (A) a coating having a refractive index of  $n > 1.8$  in a layer thickness of 20 - 250 nm
- (B) a colorless coating having a refractive index of  $n < 1.8$  in a layer thickness of 10 - 100 nm,
- (C) a colorless coating having a refractive index of  $n > 1.8$  in a layer thickness of 20 - 250 nm,
- (D) an absorbent layer having a layer thickness of 1 - 100 nm, and, optionally,
- (E) an outer protective layer (see abstract and [0010]).

As to claim 2, Schoen teaches the flake form substrate is natural or synthetic mica, glass flake,  $\text{Al}_2\text{O}_3$  flake,  $\text{SiO}_2$  flake or  $\text{TiO}_2$  flake, or a mixture thereof [ see 0018]

As to claims 3 and 4, Schoen teaches coating (A) consists of  $\text{TiO}_2$ ,  $\text{ZrO}_2$ ,  $\text{ZnO}$  or  $\text{BiOCl}$  [see 0022].

As to claims 5-7, Schoen teaches coating (B) consists  $\text{SiO}_2$ ,  $\text{MgF}_2$ ,  $\text{B}_2\text{O}_3$ ,  $\text{AlO}(\text{OH})$ ,  $\text{MgSiO}_3$  or  $\text{Al}_2\text{O}_3$ , or mixtures thereof [see 0024].

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As to claims 8-12, Schoen teaches coating (D) consists of organic and inorganic pigments that would include hematite, chromium oxide, chromium/iron mixed oxides, cadmium sulfides, selenides, chromate and etc. [see 0028].

As to claims 13-15, Schoen teaches coating (A) and (C) consists of TiO<sub>2</sub> and that layer (A) is particularly preferably a colorless layer [see 0022, lines 12-13 and 0026].

As to claim 16, Schoen teaches the pigment is produced by wet chemical methods [see 0040 and 0041].

As to claims 17, 19 and 20, Schoen teaches the pigment has industrial applications suitable for the production of flowable pigment preparation and dry preparations [see 0017, 0049,0050].

As to claim 18, Schoen teaches a pigment composition would comprise one or more binders, interference pigments and optionally one or more additives [see 0049].

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending

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Application No. 10/128,521. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications teach a multilayered pigment having a flake substrate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove  
Examiner  
Art Unit 1755

April 4, 2005

  
J.A. LORENZO  
PRIMARY EXAMINER